



Serial Number: 09/519,165

Attorney Docket No: ACT-111

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

4/26/01
JL
4/26/01

Application No.: 09/519,165
Filed: 03/06/2000
Title: Single Mask Lithographic Process For Patterning Multiple Types
Of Surface Features
Applicant(s): David W Sherrer
Gregory A. Ten Eyck
Examiner: Kin-Chan Chen
Art Unit: 1765

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir: In response to the office action mailed 3/20/01, the Applicants elect group II, claims 13-18. Applicants respectfully traverse.

The Examiner has stated:

"Restriction to one of the following inventions is required under 35 U.S.C. 121:
I. Claims 1-12, drawn to an etching method, classified in class 438, subclass 710
II. Claims 13-18, drawn to a product, classified in class 428, subclass 900.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as the deposition and etching with different masks."

The forward to the MPEP states, in relevant part: "The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations." What 37 U.S.C. 121, the law, states in relevant part: "If two or more

independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct." The Examiner has only argued that the inventions are distinct. The Examiner has not also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicants request that it be withdrawn.

Note that Applicants do not consider the explanation of the meaning of "independent" and "distinct" in MPEP § 802.01 persuasive.

The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP seem to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicants submit that statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." *Connecticut Nat'l Bank v. Germain*, 112 S. Ct. 1146, 1149 (1992). Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.' " *Id.*
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, yet MPEP § 802.01 concedes that that they do have different definitions and helpfully provides them.

Therefore, applicant suggests that the Examiner has not satisfied 35 U.S.C 121 in the restriction requirement. If the Examiner wishes to maintain the restriction requirement, applicant respectfully requests that the Examiner explain how the subject matter represents two "independent" inventions, according to the definition of "independent" given in MPEP § 802.01.

Respectfully submitted,



Dated:

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DATE OF DEPOSIT 4/17/01

SIGNED: Diane L Hughes
DIANE L. HUGHES

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